

**REMARKS**

Claims 37-68 were originally filed in the present application.

Claims 37-68 are pending in the present application.

Claims 37-42, 46-54 and 58-68 were rejected.

Claims 43-45 and 55-57 were objected to.

Claims 42, 43, 54 and 55 are currently amended.

Reconsideration of the claims is respectfully requested.

**Allowable Subject Matter**

Claims 55-57 were rejected to as being dependent upon a rejected base claim.

In light of the amendments above and arguments below, all claims are believed allowable.

**Rejections under 35 U.S.C. § 112**

Claims 37-48 and 61-68 were rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter.

There are two separate requirements under 35 U.S.C. § 112, second paragraph. MPEP § 2171, p. 2100-211 (8<sup>th</sup> ed., rev. 4, October 2005). The first is subjective and requires that the claims must set forth the subject matter that the *Applicants* regard as their invention. *Id.* The second is objective and requires that the claims must particularly point out and distinctively define the metes and bounds of the subject matter that will be protected by the patent grant (*i.e.*, whether the

scope of the claim is clear to one of ordinary skill in the art). *Id.* The Examiner should explain whether the rejection is based on indefiniteness or on the failure to claim what the Applicants regard as their invention. *Id.* at 2100-212 (citing *Ex parte Ionescu*, 222 U.S.P.Q. 537, 539 (Bd. App. 1984)).

The sole basis of these rejections is the use of the phrase “capable of” in the claims, which the Examiner appears to believe is inherently indefinite. On the contrary, those of ordinary skill in the art can easily understand whether a base station or other apparatus is capable of performing certain functions. One of skill in the art understands whether or not a “generic” piece of hardware is in a form that is capable of performing certain functions, versus whether a specially-configured or specially-programmed apparatus or piece of hardware has that capability.

The use of phrases such as “capable of” is well known in the art and in standard patent practice, and those of skill in the art understand the clear meaning. In reviewing a claim for compliance with 35 U.S.C. § 112, second paragraph, the Examiner must consider the claim as a whole to determine whether the claim appraises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. § 112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent. See, e.g., *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000). See also *In re Larsen*, No. 01-1092 (Fed. Cir. May 9, 2001) (unpublished), where the court observed that the totality of all the limitations of the claim and their interaction with each other must be considered to ascertain the inventor's contribution to the art. Upon review of the claim in its entirety, the court concluded that the claim at issue appraises one of ordinary skill in the art of its scope and, therefore,

serves the notice function required by 35 U.S.C. 112 paragraph 2. See also *Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings*, 370 F.3d 1354, 1366, 71 USPQ2d 1081, 1089 (Fed. Cir. 2004), which stated that "The requirement to 'distinctly' claim means that the claim must have a meaning discernible to one of ordinary skill in the art when construed according to correct principles .Only when a claim remains insolubly ambiguous without a discernible meaning after all reasonable attempts at construction must a court declare it indefinite."

Accordingly, a claim term that is not used or defined in the specification is not indefinite if the meaning of the claim term is discernible. *Bancorp Services, L.L.C. v. Hartford Life Ins. Co.*, 359 F.3d 1367, 1372, 69 USPQ2d 1996, 1999-2000 (Fed. Cir. 2004), which held that a disputed claim term that was not defined or used in the specification was discernible and hence not indefinite because "the components of the term have well recognized meanings, which allow the reader to infer the meaning of the entire phrase with reasonable confidence."

A cursory search of the PTO database reveals that more than two hundred twenty-eight thousand issued patents include the phrase "capable of" in the claims. This language is clear and definite, and imposes an affirmative capability requirement on the claimed systems.

Accordingly, the Applicant respectfully requests the Examiner to withdraw the § 112 rejection.

As noted in a previous response, the Examiner appears to argue that some limitations can be ignored because of this "capable of" language. This argument misapplies the decision in *In re Hutchison*, 154 F.2d 135 (CCPA 1946). In *Hutchinson*, the court did not consider the preamble

phrase “adapted for use in the fabrication of a metal template or the like” to “constitute a limitation in any patentable sense.” In contrast, the “capable of” limitation in the present application imposes capability requirements on the various claimed systems and devices. The Examiner has previously been referred to the non-precedential BPAI decision in *Ex parte Prall*, Appeal No. 2003-1556.

While the limitation at issue in Hutchinson was in the preamble and merely recited an intended use, the limitation at issue in Prall imposed a capability requirement on the respective claim element – like that in the current application.

Moreover, the determination of whether clauses such as “capable of,” “adapted to/for,” or “wherein/whereby” are a limitation in a claim is not subject to a per se rule, but instead depends on the specific facts of the case. MPEP § 2111.04, p. 2100-55 (8<sup>th</sup> ed., rev. 4, October 2005). When such a clause states a condition that is material to patentability, the clause cannot be ignored in order to change the substance of the invention. *Id.* Where the claims clearly require that the claimed systems or devices must be capable of performing specific functions, these limitations are clearly conditions material to patentability and must be considered.

### **Rejections under 35 U.S.C. § 103**

In Section 5 of the February 21, 2007 Office Action, the Examiner rejected Claims 37-41 and 49-53 under 35 U.S.C. § 103(a) as being unpatentable over U. S. Patent No. 5,966,384 to *Felix, et al*, hereafter, simply, “Felix,” in view of U. S. Patent Application Publication No. 2002/0152342 to *Das*,

*et al.*, hereafter, simply, “Das,” and U. S. Patent No. 6,373,842 to *Coverdale, et al.*, hereafter, simply, “Coverdale”.

The discussion of Felix made in a previous response is hereby incorporated by reference. Felix teaches transmitting data using a second channel and a second encoding scheme until an interruption in the transmission of data occurs at which point transmission continues on a first channel with a first encoding scheme. Felix discloses a controller that outputs an indication to stop transmission of data over the second channel when either: (1) all the data has been communicated to the remote unit; (2) an allotted time period has expired; or (3) the transmission has simply been interrupted.

In the first situation, Felix discloses that the remote unit will perform an acknowledgement of the last frames transmitted and that error control takes place when: (1) Acknowledging (ACK) packets have been received; and/or (2) Negative Acknowledgement (NAK) for messages whose sequence number has not been received even though later numbered messages have been received. Felix in Figures 5 and 7 provides limited guidance on how data may be retransmitted in Steps 427 and 527, respectively. Steps 427 and 527 indicate that any retransmission of data occurs by transmitting the data at the first transmission rate within the first bandwidth utilizing the first spreading code modulation scheme.

The Examiner does note that some retransmission in Felix’s system can occur on the fundamental channel (assuming, as the Examiner does, that the supplemental channel corresponds to the claimed “first channel”). As Felix teaches in col. 2, lines 30-35, when data transmission stops,

“any retransmission will take place utilizing the low-speed fundamental channel” (emphasis added).

As the claims require that the data rate of the second channel be higher than the data rate of the first channel, Felix’s low-speed fundamental channel cannot qualify as the claimed second channel.

Thus, Felix fails to teach or disclose the limitations of sending at least one replacement data packet to said mobile station on a second channel at a second higher data rate; and communicating with a replacement data packet controller capable of receiving said at least one replacement data packet from said base station and incorporating said at least one replacement data packet into a data packet stream to replace one of: a missing data packet and an error data packet. Such limitations are required by independent Claims 37 and 49, as well as their respective dependent claims.

The Examiner refers to Das for a teaching that a retransmission can occur at a higher rate than the original transmission. Das does teach that, in a system where the channel condition is monitored by the base station receiving a “rate indication message” from the receiver, and adjusting the rate according to the rate indication message. Das indicates that if a NACK is received, and the rate indication message indicates that conditions have improved, then the subpacket can be retransmitted at a higher rate.

A combination of Felix and Das, as the Examiner suggests, would teach that a packet can be retransmitted, at a higher rate, on the first channel and only if there is some indication that conditions have improved. Das does not teach that a second channel can or should be operated at a higher rate than the first channel, and the Examiner acknowledges that Felix contains no such teaching.

Therefore, no combination of the references can teach or suggest that a data packet missing from the first channel can be retransmitted on a second channel at a higher rate.

Further, for the combination the Examiner suggests to be operable, it would not be sufficient simply to take the “resend at a higher rate” teaching from Das; one would have to take Das’s entire teaching regarding the “channel rate indicator” in order for the adaptive transmission to operate as Das teaches. In such a case, one of skill in the art would not use this combination system to retransmit on a second channel, but would rather do just as Das teaches – retransmit on the first channel in accordance with the “channel rate indicator”. Das certainly does not teach or suggest that the channel quality of a “low-speed fundamental channel” should be measured and that the rate of the fundamental channel should be adapted, and so there is no teaching or suggestion of the claimed retransmission, on a second channel, at a higher rate than the first channel.

Nor does Coverdale teach or suggest this limitation. As these limitations are found in independent claims 37 and 49, and none of the references teach or suggest these limitations, alone or in combination, the rejections of claims 37-41 and 49-53 are traversed.

In Section 6 of the February 21, 2007 Office Action, the Examiner rejected Claims 42, 47, 48, 54, 59, and 60 under 35 U.S.C. §103(a) as being unpatentable over Das in view of U. S. Patent Application Publication No. 2001/0007819 to Kubota. In Section 7 of the February 21, 2007 Office Action, the Examiner rejected Claims 46 and 58 under 35 U.S.C. §103(a) as being unpatentable over Das and Kubota as applied to claims 42 and 54 above and in further view of Coverdale. In Section 8 of the February 21, 2007 Office Action, the Examiner rejected Claims 61-64 under 35 U.S.C.

§103(a) as being unpatentable over Coverdale in view of Das. In Section 9 of the February 21, 2007 Office Action, the Examiner rejected Claims 65-68 under 35 U.S.C. §103(a) as being unpatentable over Cloverdale in view of Das and Kubota.

These rejections are traversed.

Each of the claims requires a transmission on a second channel at a rate higher than the original transmission on the first channel (as discussed in detail above). This feature is not taught or suggested by any combination of Das and Kubota, alone or in combination with Coverdale and/or Kubota.

The error in the rejection appears to be a misreading of Das by the Examiner. The Examiner indicates that Das teaches retransmission on a second channel. Das has no teaching or suggestion of this, nor any teaching or suggestion that Das's base station is capable of this. Das only discusses "the channel" in the singular form when discussing different data rates.

Coverdale does include a passing mention that a transmission request can go over a control panel, but not that packets are retransmitted on the control channel.

As this limitation is not taught or suggested by any combination of Das, Kubota, and Coverdale, the rejection of claims 42, 46, 47, 48, 54, and 58-68 is traversed.

In particular with regard to claims 42 and 54, these claims have been amended to incorporate a limitation from a dependent claim regarding an A3 physical transition directive message, that is also not taught or suggested by any art of record, alone or in combination.

All rejections are traversed.



**SUMMARY**

For the reasons given above, the Applicant respectfully requests reconsideration and allowance of the pending claims and that this application be passed to issue. If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *jmockler@munckbutrus.com*.

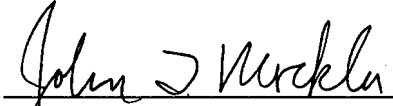
The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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